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09/621,766	07/21/2000	Frederic Heiman	602B	5346

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EXAMINER

DALENCOURT, YVES

ART UNIT	PAPER NUMBER
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2635

DATE MAILED: 10/09/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

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## Office Action Summary

Applicati n No.

09/621,766

Applicant(s)

HEIMAN ET AL.

Examin r

Yves Dalencourt

Art Unit

2635

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 24 July 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 11-16 and 33-61 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 11-16 and 33-61 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

This office action is responsive to amendment filed on 07/24/03.

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### ***Response to Amendment***

The examiner has acknowledged the amended specification, and the amended claims 14, 34, 36, 41, 51, 52, and 55.

### ***Response to Arguments***

Applicant's arguments with respect to claims 11 – 16 and 33 - 61 have been considered but are moot in view of the new ground(s) of rejection.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 11 – 16 and 33 - 41 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 - 28 of U.S.

Patent No. 6,587,034. Although the conflicting claims are not identical, they are not patentably distinct from each other because removing inherent and/or unnecessary limitations would be within the level of one of ordinary skill in the art. It is well settled that the omission of a limitation, e.g. " wherein said controller is arranged to receive a first data message, to display the first data message on the first screen, to receive a second data message on the second screen, and to signal a user to refer to the second screen"(claims 11, 33, and 41 of U.S. Patent No. 6,587,034), and its function is an obvious expedient if the remaining elements perform the same function as before. *In re Karlson*, 136 USPQ 184 (CCPA 1963). Also note Ex parte Rainu, 168 USPQ 375 (Bd. App. 1969). Omission of a reference element or step whose function is not needed would be obvious to one of ordinary skill in the art.

Claim 34 of US Application Number 09/621,766 is the same as claim 2 of U.S. Patent No. 6,587,034.

Claim 35 of US Application Number 09/621,766 is the same as claim 3 of U.S. Patent No. 6,587,034.

Claim 36 of US Application Number 09/621,766 is the same as claim 4 of U.S. Patent No. 6,587,034.

Claim 37 of US Application Number 09/621,766 is the same as claim 5 of U.S. Patent No. 6,587,034.

Claim 38 of US Application Number 09/621,766 is the same as claim 6 of U.S. Patent No. 6,587,034.

Claim 40 of US Application Number 09/621,766 is the same as claim 7 of U.S.

Patent No. 6,587,034.

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Claim 42 of US Application Number 09/621,766 is the same as claim 9 of U.S.

Patent No. 6,587,034.

Claim 43 of US Application Number 09/621,766 is the same as claim 10 of U.S.

Patent No. 6,587,034.

Claim 44 of US Application Number 09/621,766 is the same as claim 11 of U.S.

Patent No. 6,587,034.

Claim 45 of US Application Number 09/621,766 is the same as claim 12 of U.S.

Patent No. 6,587,034.

Claim 46 of US Application Number 09/621,766 is the same as claim 13 of U.S.

Patent No. 6,587,034.

Claim 47 of US Application Number 09/621,766 is the same as claim 14 of U.S.

Patent No. 6,587,034.

Claim 48 of US Application Number 09/621,766 is the same as claim 15 of U.S.

Patent No. 6,587,034.

Claim 49 of US Application Number 09/621,766 is the same as claim 16 of U.S.

Patent No. 6,587,034.

Claim 50 of US Application Number 09/621,766 is the same as claim 17 of U.S.

Patent No. 6,587,034.

Claim 51 of US Application Number 09/621,766 is the same as claim 18 of U.S.

Patent No. 6,587,034.

Art Unit: 2635

Claim 52 of US Application Number 09/621,766 is the same as claim 19 of U.S.

Patent No. 6,587,034.

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Claim 53 of US Application Number 09/621,766 is the same as claim 20 of U.S.

Patent No. 6,587,034.

Claim 54 of US Application Number 09/621,766 is the same as claim 21 of U.S.

Patent No. 6,587,034.

Claim 55 of US Application Number 09/621,766 is the same as claim 22 of U.S.

Patent No. 6,587,034.

Claim 56 of US Application Number 09/621,766 is the same as claim 23 of U.S.

Patent No. 6,587,034.

Claim 57 of US Application Number 09/621,766 is the same as claim 24 of U.S.

Patent No. 6,587,034.

Claim 58 of US Application Number 09/621,766 is the same as claim 25 of U.S.

Patent No. 6,587,034.

Claim 59 of US Application Number 09/621,766 is the same as claim 26 of U.S.

Patent No. 6,587,034.

Claim 60 of US Application Number 09/621,766 is the same as claim 27 of U.S.

Patent No. 6,587,034.

Claim 61 of US Application Number 09/621,766 is the same as claim 28 of U.S.

Patent No. 6,587,034.

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***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

Claims 11 – 16, 33 – 37, and 41 - 61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kubler et al (US 5,726,984; hereinafter Kubler) in view of Buss et al (US 5539395; hereinafter Buss), and further in view of what is known in the art of paging technology.

Regarding claims 11 – 16, 33 -37, 41 – 42, 58, and 60 - 61, Kubler et al teaches a system for scanning (figure 11) which comprises at least one mobile scanning unit (figure 28b), each comprising a scanner for scanning optical codes (3009, figure 29a); a radio module, a display, a power source and a power manager, a plurality of memory elements, and a plurality of user-depressable buttons (col. 43, lines 14 - 65; col. 46,

Art Unit: 2635

lines 30 - 43); a wired network associated with the Internet (figure 12; col. 8, lines 34 - 37); at least one access point ( col. 8, lines 37 - 46 ); wherein the at least one access point is capable of transmitting transmission data from the wired network to the at least one mobile scanning unit via a wireless medium and receiving reception data from the at least one mobile scanning unit to the wired network via a wireless medium ( figure 1c; col. 8, lines 48 - 59; col. 11, lines 12 - 22 ); wherein the at least one access point forms a transmission area, the transmission area including the space where association to the at least one access point is possible by the at least one mobile scanning unit ( figures 1b & 1c; col. 10, lines 48 - 57; col.11, lines 1 - 50 ); wherein the at least one access points broadcasts a periodic beacon via a wireless medium ( col. 19, lines 44 - 51 ); wherein each of the at least one mobile scanning unit attempts to associate with the at least one access points by broadcasting a poll via a wireless medium on a first periodic basis unless otherwise instructed by the power manager within the specific mobile scanning unit ( col. 27, lines 14 - 60; col. 37, lines 11 - 37 ).

Kubler et al teaches all the limitations, but fails to specifically teach a mobile scanning unit which comprises an annunciator to signal receipt of a paging message.

However, Buss et al teaches in an art related field of selective call receiver, a location dependent information receiving device and method which comprises an annunciator to signal receipt of a paging message ( 82, figure 3; paragraph bridging col. 2 & col. 3).

Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have used an annunciator to signal receipt of a paging message in Kubler et al's device as taught by Buss et al for the purpose of alerting a user of a received message.



Kubler et al and Buss et al teach all the limitations on claims 11 and 33, but fail to explicitly teach that the received message is alphanumeric.

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However, one skilled in the art recognizes that programming a controller to receive alphanumeric paging messages is well known.

Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have used a controller, which is programmed to receive alphanumeric paging messages in Kubler and Buss's device since it is conventional in paging technology.

Regarding claim 43, Kubler et al and Buss et al teach all the limitations, and Kubler et al further teaches a system for scanning which comprises a transmission data and a reception data that include data representing the IP address associated with each of the at least one mobile scanning unit, and wherein the wired network is connected to the Internet (figure 63; col. 99, lines 29 - 57).

Regarding claim 44, Kubler et al and Buss et al teach all the limitations, and Kubler et al further teaches a system for scanning which comprises a transmission data and a reception data that include data representing the MAC address associated with each of the at least one access point (col. 59, lines 35 - 55 ).

Regarding claim 45, Kubler et al and Buss et al teach all the limitations, and Kubler et al further teaches a system for scanning which comprises a transmission data and a reception data that include at least one unique message each of which is identified by a unique sequence number; and wherein the transmission data and the reception data include information associated with each of the at least one unique message that is identified by the unique sequence number associated with each of the at least one unique message (col. 15, lines 36 - 67).

Regarding claims 46 - 56, Kubler et al and Buss et al teach all the limitations, and Kubler et al further teaches a system for scanning which comprises a power manager that is programmed to instruct the radio module within a specific mobile scanning unit to desist attempting to associate with the at least one access point on the first periodic basis after a predetermined length of time has passed since the last successful association between the specific mobile scanning unit and the at least one access point; and which is further programmed to instruct the radio module within the same specific mobile scanning unit to resume attempting to associate with the at least one access point on the first periodic basis upon activation of one of the plurality of the user-depressable buttons within the same specific mobile scanning unit ( col. 41, lines 7 - 33; and paragraph bridging between col. 51 & col. 52 ).

Regarding claim 57, Kubler et al and Buss et al teach all the limitations, and Kubler et al further teaches a system for scanning which comprises at least one mobile scanning unit associates with the specific access point that is in closest proximity ( col. 72, lines 23 - 40 ).

Regarding claim 59, Kubler et al and Buss et al teach all the limitations, and Kubler et al further teaches a system for scanning which comprises use a TCP/IP protocol, and wherein the wired network is connected to the Internet ( figure 63; col. 99, lines 29 - 57 ).

Claims 38 - 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kubler et al and Buss et al, as applied to claim 36 above, and further in view of Weitzen et al ( US 5107259; hereinafter Weitzen).

Regarding claims 38 – 40, Kubler et al and Buss et al teach all the limitations on claim 36, but fails to specifically teach a display which comprises a first screen having a

first resolution and a second screen having a second resolution, and wherein the second resolution is higher than the first resolution.

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However, Weitzen teaches, in an analogous art, a means and method of displaying a message which comprises a first screen having a first resolution and a second screen having a second resolution, and wherein the second resolution is higher than the first resolution (figures 3A & 3B; col. 2, lines 18 – 30; col. 3, lines 25 – 48; col. 4, lines 10 - 13).

Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have used a display which comprises a first screen having a first resolution and a second screen having a second resolution, and wherein the second resolution is higher than the first resolution in Kubler and Buss's device as taught by Weitzen for the purpose of providing a selective call receiver which can display messages in at least two screens having different resolution

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Taskett et al (US 6,044,247) discloses methods and apparatus for paging systems.

Art Unit: 2635


### Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yves Dalencourt whose telephone number is (703) 308-8547. The examiner can normally be reached on M-TH 7:30AM - 6: 30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Horabik can be reached on (703) 305-4704. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9314 for regular communications and (703) 872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4700.

Yves Dalencourt



October 5, 2003